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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,803	11/26/2003	Marcus Harlowe Wolfe	W0817.00001	8202
26689	7590	04/12/2005	EXAMINER	
WILDMAN HARROLD ALLEN & DIXON			HSIEH, SHIH YUNG	
225 WEST WACKER DRIVE, SUITE 2800			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606			2837	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EL

Office Action Summary	Application No. 10/722,803	Applicant(s) WOLFE, MARCUS HARLOWE	
	Examiner Shih-yung Hsieh	Art Unit 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for producing the at least one set of musical tones in response to the random generation of notation in claim 1 and 9, and a musical instrument in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claim 9 is objected to because of the following informalities: "on set" line 4, should be one set. Appropriate correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 7-10, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hacker (5,949,010).

Regarding claim 1 and 9, Hacker discloses a method/system comprising means (Fig. 4b) for randomly generating notation representative of at least one set of musical tones' and means (Fig. 5) for producing the at least one set of musical tones in response to the random generation of notation.

Regarding claims 10 and 16, Hacker discloses an apparatus comprising a die (Fig. 4b) having musical notation one of its faces (Figs. 1b and 4b).

Regarding claim 2, Hacker discloses the claimed invention.

Regarding claim 7, Hacker inherently discloses the invention (Fig. 6, col. 2, line 41, and col. 8, lines 13-15).

Regarding claim 8, Hacker discloses the claimed invention (Fig. 6, and col. 3, lines 2-4).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-6, 11-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker in view of Ernst (DE3152034).

Regarding claims 3-6, Hacker discloses the claimed invention except the method steps recited in the claims regarding rolling a six, eight, and twelve sides/faces die.

Ernst teaches method steps of rolling an eight and twelve sided die (Figs. 1-4) for teaching identifying musical notes or chords of a tone scale (abstract). It would have been obvious to one having ordinary skill in the art to modify Hacker's method as taught by Ernst to include method steps of rolling an eight and twelve sided die for the purpose of teaching identifying musical notes or chords of a tone scale.

Regarding claims 11-15, and 17-20, see above.

7. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker in view of Ernst as applied to claims 16 and 20 above, and further in view of Eastabrook (GB2403060).

Regarding claims 21-23, Hacker in view of Ernst disclose the claimed invention except faces of the die having different notation including scale, arpeggio, thirds, fourths, fifths, sixths, and sevenths.

Eastabrook teaches a die having different musical notations and indicia on its faces (Figs. 1-3) for composing music (abstract). It would have been obvious to one having ordinary skill in the art to modify Hacker in view of Ernst's apparatus as taught by

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Eastabrook to include faces of the die having different notation including scale, arpeggio, thirds, fourths, fifths, sixths, and sevenths for the purpose of composing music.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-yung Hsieh whose telephone number is 571-272-2065. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Syh


SHIH-YUNG HSIEH
PRIMARY EXAMINER